

DATE MAILED: 01/28/2002



ĩ

## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address CCMMISSICNER OF PATENTS AND TRADEMARKS Unshington, D C. 20231 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/851,670	05/08/2001	Christoph Reinhard	PP-01699.002/200130.520	3261
75	590 01/28/2002			
Chiron Corporation			EXAMINER	
Intellectual Property R338 P.O. Box 8097			SCHMIDT, MARY M	
Emeryville, CA	94662-8097		ART UNIT	PAPER NUMBER
			1635	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
		09/851,670	REINHARD ET AL.
	Office Action Summary	Examiner	Art Unit
		Mary Schmidt	1635
	The MAILING DATE of this communication	appears on the cover sheet w	vith the correspondence address
THE N - Exter after - If the - If NO - Failui - Any r	ORTENED STATUTORY PERIOD FOR REMAILING DATE OF THIS COMMUNICATIOn is consisted to the provisions of 37 CFR SIX (6) MONTHS from the mailing date of this communication. Period for reply specified above is less than thirty (30) days, a period for reply is specified above, the maximum statutory per to reply within the set or extended period for reply will, by state ply received by the Office later than three months after the mad patent term adjustment. See 37 CFR 1.704(b).	N. R.1.136(a). In no event, however, may a reply within the statutory minimum of thi iod will apply and will expire SIX (6) MOI atute, cause the application to become A	reply be timely filed  rty (30) days will be considered timely.  NTHS from the mailing date of this communication.  BANDONED (35 U.S.C. § 133)
1)	Responsive to communication(s) filed on _		
·		This action is non-final.	
2a)☐	<i>,</i> —		attoro, proposition as to the modificie
3)	Since this application is in condition for allo closed in accordance with the practice und	•	
•	on of Claims		
	Claim(s) 1-18 is/are pending in the applica		
	4a) Of the above claim(s) is/are without	drawn from consideration.	
	Claim(s) is/are allowed.		
	Claim(s) is/are rejected.		
7)	Claim(s) is/are objected to.		
8)⊠	Claim(s) <u>1-18</u> are subject to restriction and/	or election requirement.	
Applicati	on Papers		
9) 🗌 -	The specification is objected to by the Exam	iner.	
10) 🗌 -	Fhe drawing(s) filed on is/are: a)□ ad		
	Applicant may not request that any objection to		
11)[	The proposed drawing correction filed on		disapproved by the Examiner.
40\□	If approved, corrected drawings are required in		
<i>,</i> —	The oath or declaration is objected to by the	Examiner.	
•	nder 35 U.S.C. §§ 119 and 120		
	Acknowledgment is made of a claim for fore	eign priority under 35 U.S.C.	§ 119(a)-(d) or (f).
a)(	☐ All b)☐ Some * c)☐ None of:		
	1. Certified copies of the priority docum		
	2. Certified copies of the priority docum		· · · · · · · · · · · · · · · · · · ·
* S	3. Copies of the certified copies of the p application from the International see the attached detailed Office action for a	Bureau (PCT Rule 17.2(a)).	_
	cknowledgment is made of a claim for dome	•	
	)  The translation of the foreign language Acknowledgment is made of a claim for dom	• • • •	
Attachmen	_	, ,	
1) Notic	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449) Paper No(	5) Notice of	Summary (PTO-413) Paper No(s) Informal Patent Application (PTO-152)

Application/Control Number: 09/851,670

Art Unit: 1635

## **DETAILED ACTION**

## Election/Restriction

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2-5 and 8-18, drawn to antisense compositions and methods of using antisense compositions in cells, including whole organisms, classifiable in classes 435, 536 or 514 subclasses 375, 24.5 or 44, respectively.
  - II. Claims 1, 6, 8-9, 13 and 15, drawn to ribozyme compositions and methods of using ribozymes in cells, including whole organisms, classifiable in classes 435, 536 or 514, subclasses 375, 23.2 or 44, respectively.
  - III. Claims 1, 8-9, 13 and 15, drawn to protein and polypeptide compositions and methods of using proteins/polypeptides in cells, including whole organisms, classifiable in classes 530 or 514, subclasses (300 or 350) or 2, respectively.
  - IV. Claims 1, 7-9, 13 and 15, drawn to antibody compositions and methods of using antibodies in cells, including whole organisms, classifiable in class 530, subclass 387.1.
  - V. Claims 1, 8-9, 13 and 15, drawn to small molecule compositions and methods of using small molecules in cells, including whole organisms, classifiable in classes
     435 or 536, subclasses 375 or 1.11, respectively.

Application/Control Number: 09/851,670

Art Unit: 1635

• 1

- 2. Note that claims 1, 8-9, 13 and 15 are generic to all Groups I-V. Upon election of a Group, these elected claims will be examined on the merits for the elected genus (antisense, ribozyme, protein/polypeptide, antibody or small molecule) specified in that Group.
- 3. The inventions are distinct, each from the other because of the following reasons:
- Inventions I, II, III, IV and V are unrelated from each other. Inventions are unrelated if it 4. can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different chemical structures and different modes of operation based on their different chemical structures. Specifically, the invention of Group I is drawn to antisense compositions and their use. Antisense compositions are typically short nucleic acid oligonucleotides which operate by binding to a target gene followed by degredation by the enzyme RNAse H. The invention of Group II is drawn to ribozyme compositions and their use. Ribozyme compositions are typically RNA compositions with specific structures such as binding arms and catalytic properties which allow the RNA to bind a target nucleic acid and cleave the target nucleic acid without the aid of an additional nuclease. The invention of Group III is drawn to protein or polypeptide compositions and their use. Protein and polypeptide compositions are comprised of amino acids which function therapeutically by interacting with other proteins such as receptors for instance, not via the nucleic acid interactions of antisense and ribozymes. The invention of Group IV is drawn to antibody compositions and their use. Antibodies are specific types of proteins which have immune function and bind specific epitopes or proteins depending on

Art Unit: 1635

the target protein they were designed to bind. The invention of Group V is drawn to small molecule compositions and their use. Small molecule compositions are art recognized as organic molecules which are not nucleic acids or amino acids and have the capability to bind proteins such as receptors for instance. Due to the divergent structures and corresponding divergent modes of action of the compositions in each of the above designated Groups, the compositions are considered patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a 5. separate status in the art as shown by their divergent classification and recognized divergent subject matter, and the search required for each of Group I, II, III, IV or V is not required for the other Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the 6. inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Analyst, *Katrina Turner*, whose telephone number is (703) 305-3413.

JOHN L. LEGUYADER
SUPERVISORY PATENT CXAMINER
TECHNOLOGY CENTER 1600